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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,492	08/06/2003	Dan Settanni	H-552	8669
41245	7590	01/03/2005	EXAMINER	
MARK LEVY & ASSOCIATES, PLLC PRESS BUILDING, SUITE 902 19 CHENANGO STREET BINGHAMTON, NY 13901			MEISLIN, DEBRA S	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/634,492	SETTANNI, DAN
	Examiner	Art Unit
	Debra S Meislin	3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 November 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fisher.

Note the first socket element (2, 3,10), the second socket element (8), handle (1), first and second hinges forming dual hinges (unnumbered), and locking hinge pins (unnumbered).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher in view of Scull.

Fisher discloses all of the claimed subject matter except for having square hole in the handle. Note that the handle of Fisher is attached to the first socket element at a location offset from the axis of the socket cavity. Scull discloses a square hole in the handle. It would have been obvious to one having ordinary skill in the art to form the connection between the handle and first socket cavity of Fisher with a square hole to enable the engagement of a wrench to provide torque thereto as taught by Scull.

5. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher in view of Scott.

Fisher discloses all of the claimed subject matter except for having an elongate arm. Scott discloses a first socket element (8), a second socket element (1), and an elongate arm extending from the first socket element and having plural openings (9) therein. It would have been obvious to one having ordinary skill in the art to form the adjusting elements of the device of Fisher as an arm extending from the first socket element and having openings therein to allow for the adjustability thereof as taught by Scott.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Note that Fisher is capable of engaging nuts/bolts.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher in view of Scott as applied above, in further view of Scull.

Note that the handle of Fisher is attached to the first socket element at a location offset from the axis of the socket cavity. Scull discloses a square hole in the handle. It would have been obvious to one having ordinary skill in the art to form the connection

between the handle and first socket cavity of Fisher with a square hole to enable the engagement of a wrench to provide torque thereto as taught by Scull.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Applicant's arguments filed November 18, 2004 have been fully considered but they are not persuasive.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Note that Fisher is capable of engaging nuts/bolts.

Fisher discloses locking pins as broadly claimed by applicant.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of

the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's arguments throughout pages 6-8 are directed to functional limitations or structural elements not set forth in the claims (e.g., page 6, lines 11-13; page 7, lines 19-23; page 8, lines 1-16). Applicant has not provided arguments directed to the **claimed** language and how the **claimed** language may read over the prior art of record.

It is noted that applicant's claimed language does not preclude additional structures.

Scull was not applied to the rejection of the claims to teach a "click type torque wrench handle". Scull was applied to the rejection of the claims to teach only the concept of providing a square hole to enable the engagement of a wrench to provide torque thereto. The claims do not preclude the use of a "click-type wrench". Note that applicant uses the term "ratchet" in the claims.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is some teaching, suggestion, or motivation to do so found in the references themselves. It would have been obvious to form the connection between the handle and first socket

cavity of Fisher with a square hole to enable the engagement of a wrench to provide torque thereto as taught by Scull.

Fisher in view of Scott disclose the subject matter of claims 4-5. Fisher discloses all of the claimed subject matter except for having an elongate arm. Scott discloses a first socket element (8), a second socket element (1), and an elongate arm extending from the first socket element and having plural openings (9) therein. It would have been obvious to one having ordinary skill in the art to form the adjusting elements of the device of Fisher as an arm extending from the first socket element and having openings therein to allow for the adjustability thereof as taught by Scott.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra S Meislin whose telephone number is 571 272-4487. The examiner can normally be reached on M-F, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Debra S Meislin
Primary Examiner
Art Unit 3723

December 23, 2004